

PATENTIN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Keyvan Sayyah) Examiner: Le, Thao P. Art Unit: 2818
Patent Appl: 09/924,158) Our Ref: B-3297CIP
Filed: August 7, 2001) 618935-7
For: "A METHOD OF PLACING ELEMENTS) Date: March 4, 2003
INTO RECEPTORS IN A SUBSTRATE") Re: *Response to Restriction Requirement*

13/ Elate
C. Stutz
3-6-03

RESPONSE TO RESTRICTION REQUIREMENT

Commissioner for Patents
Washington, D. C. 20231

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Sir:

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This paper is filed in response to the Office Action, dated February 21, 2003.

In response to the Office Action mailed on February 21, 2003, the Applicant provisionally elects "Species II," that is Claims 22 - 34 for further examination in this Application. However, the Applicant submits that the restriction requirement has been improperly made and traverses the restriction requirement.

In the Office Action, the Examiner asserts the application contains claims directed to the two patentably distinct species of the claimed invention: Species I comprising Claims 1 - 21 and Species II, comprising Claims 22 - 34.

The Examiner is respectfully directed to MPEP 806.04(e), which describes "Claims restricted to Species." Specifically, MPEP 806.04(e) states:

"Claims are definitions of inventions. *Claims are never species.*" (emphasis in original).

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However, in the Office Action, the Examiner seems to state that Claims 1 – 21 are Species I and Claims 22 – 34 are Species II. Clearly, the Examiner's definition of the "species" of the present application differs from the definition of "species" as provided by the Patent Office in the MPEP. Hence, the Applicant submits that the restriction requirement as set forth by the Examiner in the Office Action is improper and requests its withdrawal.

Further, MPEP 816 requires that "the particular reasons relied on by the examiner for holding that the inventions as claimed are either independent or distinct should be concisely stated." MPEP 816 further states that "a mere statement of conclusion is inadequate." The Applicant submits that the Examiner has not presented any reasons as to why the invention as claimed in Claims 1 – 21 is independent or distinct from the invention claimed in Claims 22 – 34.

It appears that the only reason on which the examiner bases the restriction requirement is the presence of two independent claims in the application. The Examiner is reminded that 35 U.S.C. 121 authorizes, but does not require, the Director to restrict an application if two or more independent and distinct inventions are claimed in an application. Hence, before issuing a restriction requirement, the Examiner should at least provide some showing that the inventions as claimed are independent and distinct, rather than basing the restriction requirement solely on the presence of multiple independent claims in the application. Therefore, the Applicants submit that the restriction requirement set forth in the Office Action of February 21, 2003 is improper. As such, reconsideration is respectfully requested and the Examiner is respectfully requested to withdraw the restriction requirement.

The Applicant further submits that the restriction requirement is not being traversed on the grounds that the species are not patentably distinct. Therefore, if the Examiner should find that elected or non-elected group of claims is unpatentable over the prior art, this traversal of the restriction requirement should not be deemed as evidence or an admission that may be used in a rejection under 35 U.S.C. 103(a) of the other group of claims.

The Commissioner is authorized to charge any additional fees which may be required or credit overpayment to deposit account no. 12-0415. In particular, if this response is not timely filed, the Commissioner is authorized to treat this response as including a petition to extend the time period pursuant to 37 CFR 1.136(a) requesting an extension of time of the number of months necessary to make this response timely filed and the petition fee due in connection therewith may be charged to deposit account no. 12-0415.

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March 4, 2003

(Date of Deposit)

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Respectfully submitted,

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